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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/714,315	11/16/2000	Sharon Greener	3499-91	6479

27383 7590 03/11/2004

CLIFFORD CHANCE US LLP
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NEW YORK, NY 10166

EXAMINER

SNAPP, SANDRA S

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 03/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/714,315

Applicant(s)

GREENER ET AL.

Examiner

Sandra Snapp

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-59 is/are pending in the application.
- 4a) Of the above claim(s) 15-34, 45-51 and 53-59 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14, 35-44 and 52 is/are rejected.
- 7) ☒ Claim(s) 7, 35, 41 and 44 is/are objected to.
- 8) ☒ Claim(s) 15-34, 45-51 and 52-59 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 November 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>8 & 12</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

During a telephone conversation with Mr. Joseph Kincart on 2-12-4 a provisional election was made without traverse to prosecute the invention of the method and related system for pricing a transaction, claims 1-14, 35-44 and 52. Affirmation of this election must be made by applicant in replying to this Office action. Claims 15-34, 45-51 and 53-59 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention. Applicant must cancel the claims that are herein withdrawn from consideration.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Information Disclosure Statement

The information disclosure statements (IDSs) submitted on 2-22-01, 1-16-02 and 10-28-02 were filed in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statements were considered by the examiner.

Claim Objections

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Claims 7, 35, 41 and 44 are objected to because of the following informalities:

In claim 7, the phrase “with participant of the transaction” is awkward and grammatically incorrect. The Examiner suggests amending the phrase to read, “with *a* participant of the transaction.”

In claims 35, 41 and 44, the phrase “relating to deliverable involved” is awkward and grammatically incorrect. The Examiner suggests amending the phrase to read, “relating to *a* deliverable involved.” Also, in Claim 35, the term “xtended” is misspelled and should be “extended.”

Also in claims 41 and 44, the semicolon after the phrase “for the deliverable” (line 7 in claim 41, and line 8 in claim 44) is confusing. It is unclear what the Applicant intends by using the semicolon in this manner. Clarification is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3, 8, 9, 37, 39 and 43 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 3 and 37 are indefinite because the limitation of the detail of the price comprising the cost of credit involved, the cost of exchange and the amount relating to the deliverable is confusing since it has already been recited in claims 1 and 35, respectively, with regard to the price (itself) of the deliverable. Isn't this subsequent recitation redundant?

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Claims 8, 9 & 39 are indefinite because it is unclear whether the purchasing party is the same as the buyer in their respective independent claim (1 and 35)?

Claim 43 is indefinite because it is unclear whether the phrase "to online transaction" is referring to "the transaction" of claim 42 or a different transaction. Clarification is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-14 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are directed to non-statutory subject matter because they lack any reference to technology. The Patent Office has taken the position that claims lacking any reference to technology are "nothing more than [an] abstract idea which is not tied to any technological art and is not a useful art as contemplated by the Constitution." *Ex parte Bowman*, 61 USPQ2d 1669, 1671 (Bd. Pat. App. & Inter. 2001)(Unpublished). Although the Bowman case is not precedential, it is cited herein merely for its content and reasoning to illustrate the Patent Office's current position on this issue. The Examiner suggests amending the claims to include some form of technology, such as a computer, etc. in the body of the claim. It is not sufficient to merely put such technology in the preamble.

Claims 42-43 and 52 are rejected under 35 U.S.C. 101 because the claims are directed to non-significant use of technology, that is, the technology referenced in the claims is not connected to the method steps as recited. For example, in a simplified reading of claim 42, the claim would appear to transmit data, receive data and display data which is merely non-

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significant use of the technology recited in the preamble. As such, under 35 U.S.C. 101, non-significant data is non-statutory and does not necessarily lead to a useful, concrete, tangible result.

Claim 44 is rejected under 35 U.S.C. 101 because the claim is directed to non-statutory subject matter. The Patent Office has taken the position that signals are not statutory subject matter unless it is embodied in a physical, tangible medium such as some form of computer readable memory, and is couple with computer executable code. As such, the language of claim 44 is also directed to non-functional descriptive material and non-statutory.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-14, 35-44 and 52 are rejected under 35 U.S.C. 102(b) as being anticipated by the Boesch et al. patent (US 5,897,621).

With regard to claims 1-14, the Boesch patent discloses a computer-implemented method and the associated computer system for providing pricing for a transaction, the method comprising:

Receiving an amount relating to a deliverable involved in a transaction (col. 7, lines 25-34), determining a cost for credit to be extended to a buyer (col. 8, lines 12-38), calculating a

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cost for exchange of currency (col. 8, lines 12-38), and calculating a price for the deliverable (col. 8, lines 12-38) (claims 1 and 35);

Transmitting the calculated price to a participant network access device (col. 8, lines 12-38) (claims 2 and 36);

Transmitting a detail of the price wherein the detail is comprised of the cost of credit, the cost for the exchange, and the amount relating to the deliverable (col. 8, lines 12-38) (claims 3 and 37);

Discounting the cost of exchange of currency according to a volume discount term relating to a notional volume associated with a participant of the transaction (col. 8, lines 54-58) (claims 4 and 38);

The aggregate notional volume is calculated on a periodic basis (col. 8, lines 65-67) (claim 5);

Discounting the cost of exchange of currency according to a volume discount term relating to an aggregate number of transactions associated with a participant of the transaction (col. 8, lines 54-58) (claim 6);

Discounting the cost of exchange of currency according to a discount term relating to a payment history associated with the participant of the transaction (col. 8, lines 54-58 and col. 9, line 53 through col. 10, line 8) (claim 7);

The amount received relating to the deliverable is determined according to data comprising the identity of a purchasing party involved in the transaction (col. 5, lines 23-36) (claim 8);

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The cost for exchange of currency relating to the transaction is determined according to data comprising the identity of a purchasing party involved in the transaction (col. 5, lines 23-36) (claims 9 and 39);

The amount received relating to the deliverable is determined according to data comprising a transaction facilitator (col. 8, lines 24-39) (claims 10 and 40);

Processing payment for the deliverable in the amount relating to the deliverable (col. 8, lines 24-39) (claim 11);

Receiving notification of shipment of the deliverable prior to processing payment for the deliverable (col. 4, lines 5-7) (claim 12);

Determining an exchange price and tolerance parameter for a foreign currency in which the amount relating to the deliverable is denominated, as the foreign currency relates to a base currency (col. 8, line 59 through col. 9, line 24), receiving a spot price relating to a market price for exchange of a foreign currency, comparing the spot price with the tolerance parameter, and modifying the exchange price if spot price exceeds the tolerance parameter (col. 8, line 59 through col. 9, line 24) (claim 13);

Entering an exchange price to be utilized in calculating a cost of exchange of currency relating to the transaction (col. 8, line 59 through col. 9, line 24), entering a predetermined time period for which the exchange price will remain valid (col. 4, line 66 through col. 5, line 8), determining if the transaction will take place during the predetermined time period (col. 8, lines 59-67), and entering an updated exchange price if the transaction will take place during a time other than the predetermined time period (col. 8, lines 59-67) (claim 14);

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With regard to claim 41, the Boesch patent also discloses computer executable program code causing the computer to (computer info col. 5, lines 55-64, the program code is inherent in a system having a computer and the steps as presently claimed):

Receive an amount relating to a deliverable involved in a transaction (col. 7, lines 25-34), determine a cost credit to be extended to a buyer, wherein the credit is extended resultant to the transaction (col. 8, lines 12-38), calculate a cost for exchange of currency (col. 8, lines 12-38), and calculate a price for the deliverable (col. 8, lines 12-38) (claim 41).

With regard to claims 42-43, the Boesch patent discloses a method of interacting with a network access device so as to provide pricing information, the method comprising the steps of:

Causing details of an online transaction involving a calculated price and detail of a price to be transmitted to a participant network access device (col. 8, lines 12-38), receiving an amount deliverable involved in a transaction (col. 8, lines 12-38), and displaying the calculated price and detail of the price related to the transaction (col. 8, lines 12-38) (claim 42); and

Displaying multiple calculated and detail prices related to the online transaction (col. 10, lines 39-64) (claim 43).

With regard to claim 44, the Boesch patent discloses a computer data signal embodied in a digital data stream comprising data including e-commerce details (computer info col. 5, lines 55-64, the data signal is inherent in a system having a computer and the method steps as presently claimed), wherein the computer data signal is generated by a method comprising:

Receiving an amount relating to a deliverable (col. 7, lines 25-34), determining a cost credit to be extended a buyer, wherein the credit is extended resultant to the transaction (col. 8,

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lines 12-38), calculating a cost for exchange of currency relating to the transaction (col. 8, lines 12-38), calculating a price for the deliverable (col. 8, lines 12-38) (claim 44).

With regard to claim 52, the Boesch patent discloses a method of interacting with a network access device so as to provide pricing for a transaction, the method comprising:

Identifying parties involved in a transaction (col. 5, lines 23-36), defining a deliverable with a currency amount associated with the deliverable (col. 7, lines 25-34), and receiving a price for the deliverable (col. 8, lines 12-38) (claim 52).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The Garber, Uchida et al., Wolf et al., Gell et al., Fraser et al., Walker et al., Bekaert et al., Giovannoli, Silverman et al., Chennault, Potter et al., Hartheimer et al., Midorikawa et al., Odom et al., Harrington et al., Walker et al., Jong and Rosen patents disclose various types of electronic exchange or trading systems and financial systems.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sandra Snapp whose telephone number is 703-305-6940. The examiner can normally be reached on Mon.-Thurs..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703-308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SS


SANDRA S. SNAPP
PATENT EXAMINER
GROUP 3600



FORM PTO-1449 U.S. Department of Commerce Patent and Trademark Office

INFORMATION DISCLOSURE STATEMENT

(Use several sheets if necessary)

Serial No. 09/714,315

Inventors: Greener et al.

Docket No. 3499-091

U.S. PATENT DOCUMENTS

EXAMINER INITIAL	DOCUMENT NUMBER	DATE	NAME	CLASS	SUBCLASS	FILING DATE IF APPROPRIATE
SS	5,787,402	7/28/98	Potter et al.	705	37	10/8/96
SS	5,963,923	10/5/99	Garber	705	37	6/3/97

FOREIGN PATENT DOCUMENTS

EXAMINER INITIAL	DOCUMENT NUMBER	DATE	COUNTRY	TRANSLATION

OTHER DOCUMENTS

EXAMINER INITIAL	AUTHOR, TITLE, DATE, PERTINENT PAGES, ETC.
SS	International Search Report for PCT/US01/21812 dated October 18, 2001

EXAMINER

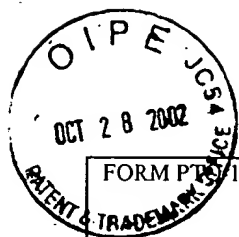
Sandra Snapp

DATE CONSIDERED

2/12/9

EXAMINER: Initial if citation considered, whether or not citation is in conformance with M.P.E.P. 609; draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

Form PTO-1449 [6-4]



FORM PTO-1449 U.S. Department of Commerce Patent and Trademark Office

INFORMATION DISCLOSURE STATEMENT

(Use several sheets if necessary)

Serial No. 09/714,315

Inventors: Greener et al.

Docket No. 3499-91

U.S. PATENT DOCUMENTS

EXAMINER INITIAL	DOCUMENT NUMBER	DATE	NAME	CLASS	SUBCLASS	FILING DATE IF APPROPRIATE
SS	2001/0056398	12/27/01	Scheirer	705	38	4/12/01
SS	2002/0016762	2/7/02	Feilbogen et al.	705	39	5/31/01
SS	2002/0046053	4/18/02	Hare et al.	705	1	8/21/01
SS	6,205,433 B1	3/20/01	Boesch et al.	705	26	12/17/98

FOREIGN PATENT DOCUMENTS

EXAMINER INITIAL	DOCUMENT NUMBER	DATE	COUNTRY	TRANSLATION
SS	WO 02/11018	2/7/02	WO	Yes

OTHER DOCUMENTS

EXAMINER INITIAL	AUTHOR, TITLE, DATE, PERTINENT PAGES, ETC.
SS	Int'l Search Report dated September 19, 2002 for PCT/US01/51200.

RECEIVED
OCT 31 2002
GROUP 3

EXAMINER

Samara Snapp

DATE CONSIDERED

2/12/4

EXAMINER: Initial if citation considered, whether or not citation is in conformance with M.P.E.P. 609; draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

Form PTO-1449 [6-4]

FORM PTO-1449 U.S. DEPARTMENT OF COMMERCE PATENT & TRADEMARK OFFICE

LIST OF PRIOR ART CITED BY APPLICANT

DOCKET NO : 3499-91 SERIAL NO :
 APPLICANT : Greener et al. EXAMINER : Not assigned
 FILING DATE : GROUP ART UNIT

U.S. PATENT DOCUMENTS

*EXAMINER'S INITIALS	DOCUMENT NUMBER	CLASS	SUBCLASS	DATE
SS	5,884,274	705	4	3/16/99
SS	5,897,621	705	26	4/27/99

FOREIGN PATENT DOCUMENTS

*EXAMINER'S INITIALS	DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUBCLASS	TRANSLATION YES NO
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OTHER PRIOR ART(INCLUDING AUTHOR, TITLE DATE, PERTINENT PAGES, ETC.)

*EXAMINER

Currenex web site, <<http://www.currenex.com>>;Homepage, <<http://www.currenex.com/home.html>>Foreign Exchange Market, <<http://www.currenex.com/foreign.html>>About Currenex, <<http://www.currenex.com/about.html>>FAQ, <<http://www.currenex.com/faq.html>>FX Trades Services, <<http://www.currenex.com/services.html>>.

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“Citigroup and AOL Form Pact Allowing Cash to Be E-Mailed”, The Wall Street Journal, July 19, 2000, C23.

“Currenex Launches Multi-Bank Web Based FX Trading System”, fxweek, May 1, 2000, Vol. 11, No. 18.

- SS "Netscape, Citibank Unveil Credit Card", Dow Jones News Service, January 19, 2000.
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- SS Kraus, James R., "National/Global Forex Trading Sites May Erode Bank Revenues", The American Banker.com, May 4, 2000.
- SS Mullen, Theo, "Service Aids Selling to Europeans", InternetWeek, July 17, 2000, 13.
- SS Power, Carol, "AOL Digs Deeper Into Virtual Financial World", The American Banker, August 11, 1999, On-line Banking 1.
- SS Power, Carol, "Citi Advances in Online Payments, Aggregation; Strikes Partnerships with AOL and Yodlee.com", The American Banker, July 19, 2000, Technology 1.
- SS Rogerson, Paul, "The Right to Choose", The Accountant, August 1, 1999, 12.
- SS Tompor, Susan, "Does it Make Sense to Spread the Wealth Around?", The Florida Times-Union, July 11, 1999, H1.
- SS Wilkinson, Claire, "Insurance Review: Citigroup in AOL Online Alliance Plan", Lloyd's List, July 21, 2000, 8.

INITIALS

EXAMINER: Sandra Snapp DATE CONSIDERED: 2/12/4

*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609; draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

